

REMARKS/ARGUMENTS

Favorable reconsideration of this application in view of the above amendments and in light of the following discussion is respectfully requested.

Claims 1, 2, 4-11, 13 and 15-23 are pending in the present application. The present Amendment amends Claim 22 to overcome the §101 rejection. No new matter is introduced.

In the outstanding Office Action, Claims 13 and 15-22 were rejected under 35 U.S.C. §101 as directed to non-statutory subject matter; Claims 1, 4-10, 15-20 and 22 were rejected under 35 U.S.C. §102(e) as anticipated by Matsushima (U.S. Pat. Pub. No. 2002/0144257); and Claims 2, 11, 13, 21 and 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over Matsushima in view of Washino (U.S. Patent No. 5,537,157).

With regard to the rejection of Claims 13 and 15-22 under §101, as directed to non-statutory subject matter, independent Claim 22 has been amended to overcome the rejection. Specifically, Claim 22 has been amended to recite a non-transitory computer readable medium claim. Accordingly, in light of the amendment to Claim 22, Applicants respectfully request that the rejection of Claims 13 and 15-22 under §101, be withdrawn.

Addressing now the rejection of Claim 1, 4-10, 15-20 and 22 under 35 U.S.C. §102(e) as anticipated by Matsushima, Applicants respectfully traverse this rejection.

Claim 1 recites,

An image forming apparatus that includes service modules for performing system side processes on image formation, wherein applications can be added to the image forming apparatus separately from the service modules, the image forming apparatus comprising:

an application launch part configured to access launch selection information, the launch selection information indicating at least an auxiliary storage device that stores one or more applications from among a plurality of kinds of auxiliary storage devices, and configured to launch the one or more applications from the auxiliary storage device according to the accessed launch selection information; and

a part configured to display a setting screen that sets the launch selection information on a display part of the image

forming apparatus, and configured to store information input from the setting screen as the launch selection information,  
wherein the service modules are stored in a memory distinct from the auxiliary storage device,  
wherein the one or more applications are installed in the auxiliary storage device, and  
wherein the application launch part launches the one or more applications from the auxiliary storage device by issuing an execution command which is stored in the auxiliary storage device.

Claim 22 recites similar features and Claim 23 recites at least the above noted features.

Matsushima describes a multifunction machine which executes software downloaded into the multifunction machine.

However, Matsushima does not describe or suggest, at least, that the application launch part launches the one or more applications from the auxiliary storage device by issuing an execution command which is stored in the auxiliary storage device.

The outstanding Action asserts on page 10 that

referring to Fig. 4, a process of downloading a software component, i.e. multifunction machine 10 sends a request command for authentication in Step 404, and receives the authentication information from Server 20 in Step 407; multifunction machine 10 access the target URL and Server 20 transmit the requested software component to multifunction machine 10 in Steps 408 to 411; thus, executing commands such requesting authentication, accessing to the target URL and downloading the software components are stored in Server 20 so that a software download communication is established, Pars. [0070] to [0075]

Further the outstanding Action asserts on page 3 that

In re, the examiner respectfully disagrees with the above argument. The word "launch" means "to start" or "to give a start", see dictionary.com; an application launch part, is a part to give a start of an application; Matsushima discloses a web browser, i.e. Browser 135 of Fig. 2, to start or to launch the application plug-in for downloading the software, see step 402 of Fig. 4, Pars. [0070] and [0072].

In response, Applicants respectfully traverse these assertions.

The outstanding Action appears to have associated the “browser application” 135 with the claimed “application launch part.” Furthermore, the outstanding Action appears to have associated the claimed “one or more applications” with “the application plug-in for downloading the software.” In addition, the outstanding Action asserts that the claimed “auxiliary storage device” corresponds to the external “server 20” of Matsushima.

In response, Applicants note that the claimed invention recites that the “one or more applications” are launched “from the auxiliary storage device.” In contrast, the “the application plug-in for downloading the software” of Matsushima ***is not launched from the server 20.***

Moreover, the outstanding also appears to assert that the claimed “execution command” corresponds to the steps of “requesting authentication, accessing to the target URL and downloading the software components” of Matsushima.

In response, Applicants note that the claimed invention recites that the execution command is stored in the auxiliary storage device. In contrast, the ***commands executing*** the steps of “requesting authentication, accessing to the target URL and downloading the software components” ***are not stored in the server 20.***

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *See In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)). In the present case, the cited Matsushima reference clearly ***does not disclose each and every limitation of the claimed invention.***

In addition, although the outstanding Action has rejected the claims under 35 U.S.C. §102(e), the Action provides comments consistent with a §103(a) rejection. Specifically, the outstanding Action on pages 3-4 asserts that

one skill[ed] in the art realized that a network can have multiple devices, i.e. servers, computers and their peripherals

such [as] printers and copier machines connected as shown in Figs. 10A-B, 14 and 15 etc., thus downloading a software component from Server 20 implies downloading an application from among a plurality of kinds of auxiliary devices.

This language implies that although the cited Matsushima reference does not explicitly describe a plurality of kinds of auxiliary storage devices, it would be obvious to implement such a configuration based on the disclosure of Matsushima.

Moreover, it is well established that ambiguous showings subject to different interpretations (here whether a plurality of kinds of auxiliary storage devices are disclosed in Matsushima) cannot be relied upon to establish anticipation. See, e.g., *In re Turlay*, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In order to establish **anticipation**, there must be clear and unequivocal disclosure by the reference, not just unsupported conclusions as to what the reference might have been suggesting. See *In re Hughes*, 145 USPQ 467, 471 (CCPA 1965) and *In re Moreton*, 129 USPQ 227, 230 (CCPA 1961).

Thus, Applicants respectfully submit that Claim 1, and similarly Claims 22, and claims depending respectfully therefrom, patentably distinguish over Matsushima considered individually or in any combination.

Accordingly, Applicants respectfully request that the rejection of Claims 1, 4-10, 15-20 and 22 under 35 U.S.C. §102(e), be withdrawn.

Furthermore, with regard to Claim 23, Applicants respectfully submit that this claim patentably distinguishes over Matsushima and Washino considered individually or in combination for at least the reasons noted above with regard to Claim 1 (which also apply to Claim 23), as Washino does not cure the deficiencies of Matsushima with regard to the claimed invention.

Furthermore, the outstanding Action appears to assert on page 5 that features of the claimed invention can be ignored as being “functional,” in other words that the function cannot be relied upon to distinguish the prior art based on language found in MPEP §2114.

However, the case law cited in this section as well as other controlling precedent does not support the conclusion that a claimed function can be ignored. In this regard, *In re Schreiber*, 128 F.3d 1473, 1477-78 44 USPQ 2d 1429, 1431-32 (Fed. Cir. 1999) (cited as authority in the noted MPEP §2114 ) does not support any theory that functional limitations can be ignored, rather this case requires that a reference structure used to reject a claim structure defined by what it does must inherently perform the claimed function. In this regard, it is well established that inherency requires the certainty that something will happen, not merely a possibility or even a probability that something may occur. See *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) and *In re Oelrich*, 212 USPQ 323, 326 (CCPA 1981).

Again note the further discussion of functional limitations in MPEP §2173.05(g) that specifically treats the *Swinehart* decision (*In re Swinehart* 439 F.2d 210, 169 USPQ 226 (CCPA 1971)) mentioned in MPEP §2114 as noting that functional limitations defining structure by the function performed by that structure are valid claim limitations that this section instructs “***must be evaluated and considered, just like any other limitation of the claim . . .***” (emphasis added).

Therefore, Applicants respectfully submit that all features recited in the claims should be considered and given their full meaning.

Consequently, for the reasons discussed above, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance for Claims 1, 2, 4-11, 13 and 15-23 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

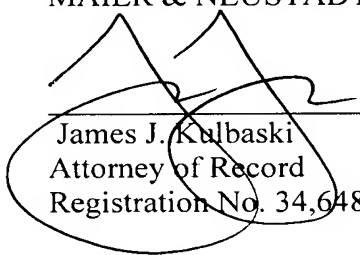
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, L.L.P.

Customer Number

**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 07/09)

4205853\_1



---

James J. Kulbaski  
Attorney of Record  
Registration No. 34,648

James Love  
Registration No. 58,421